

Appl. No. 10/612,580
Amdt. dated August 2, 2006
Reply to Office action of February 3, 2006

Remarks:

Reconsideration of the application is requested.

Claims 1 to 30 remain in the application. Claims 1 to 18 are subject to examination and claims 19 to 30 have been withdrawn from examination. Claims 1, 7, 8, and 11 to 14 have been amended.

On pages 2 and 3 of the above-identified Office action, claims 1 to 18 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

More specifically, the Examiner first states that the term "pure" is recited in the claim to render the claim indefinite. This term has been removed from claims 1 to 18 and, therefore, this rejection is now moot.

Second, the Examiner believes that claim 1 is incomplete for omitting an essential element - "a heater or heating element that causes evaporation. The [Examiner also states that the] claimed 'distillation chamber', by definition, includes both evaporator and condenser, and could not serve as a heater."

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Applicant cannot agree with this statement. The specification describes how the distillation chamber of the present invention incorporates and includes a heating element for heating the water provided therein. Applicant can be its own lexicographer and, thereby, define the distillation chamber as including a heater. See *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 45 USPQ2d 1429 (Fed. Cir. 1998); *Fromson v. Advance Offset Plate, Inc. et al.*, 219 U.S.P.Q. 1137, 1140 (Fed. Cir. 1983). In this case, Applicant did so by the description and drawings in the specification and by indicating in the claim that the distillation chamber is for heating the tap water therein. Accordingly, specific inclusion of a heater in claim 1 does not add any additional limitation to claim 1. Simply to remove this rejection, applicants have mentioned the incorporated heater in claim 1. It is believed that this inclusion does not narrow the distillation chamber feature because the claim already provided that the chamber heated the tap water.

Third, the Examiner states: "The claimed 'said post-filter capturing impurities from the condensed vapors' in claim 1 lacks antecedent support when the distillation chamber is selected from the recitation of 'at least one of said distillation chamber and said condenser.'"

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Applicant has eliminated the phrase "at least one of" from the fifth paragraph of the body of claim 1. Therefore, it is respectfully believed that this rejection is now moot.

Fourth, the Examiner states: "It is unclear what is being filtered, the 'condensed vapors' recited in line 11, or the condensed liquid', recited in line 13 of claim 1. The terms 'condensed vapor' and 'condensed liquid' are also ambiguous. The 'liquid' in the latter recitation, for example, is the condensate or distillate already condensed from the -vapor--."

It is respectfully believed that the cited terms in claim 1 are not ambiguous. Nonetheless, to even more clearly explain the post-filter, claim 1 provides that the post-filter captures impurities from the vapors and the condensed liquid to produce distilled water and that the filter material filters the vapors and the condensed liquid. Based upon these clarifications, it is respectfully believe that the rejection is now moot.

Finally, the Examiner indicates that "said flavor agent" lacks antecedent basis. The Examiner has correctly identified a typographical error existing in claim 14, which should have

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dependent upon claim 13. This error has been corrected. The cited phrase has antecedent basis in claim 13.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, second paragraph. The above noted changes to the claims are provided solely for the purpose of satisfying the requirements of 35 U.S.C. § 112. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

On pages 3 and 4 of the above-identified Office action, claims 1 to 18 have been rejected as being obvious over either United States Patent No. 5,196,093 to Weber et al. (hereinafter "Weber") or No. 5,762,762 to Breithaupt et al. (hereinafter "Breithaupt") in view of either United States Patent No. 5,827,374 to Mansur (hereinafter "Mansur I") or No. 6,227,214 to Mansur (hereinafter "Mansur II") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references.

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Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*, a self-cleaning water purification apparatus for automatically creating distilled water for dispensing on demand, including:

an input tube to be connected to a household tap water supply for receiving tap water;

a distillation chamber communicating with the input tube and having a heater for heating the tap water to a boiling temperature and producing vapors therefrom;

a post-filter communicating with the distillation chamber and a condenser, the post-filter capturing impurities from the vapors and the condensed liquid to produce distilled water in a distillation cycle, the post-filter having:

a filter material for filtering the vapors and the condensed liquid; and

a post-filter heating element for superheating the water in the filter material to clean the filter material during a rejuvenation cycle; and

a cleaning agent chamber containing a cleaning agent, the cleaning agent chamber communicating with the distillation chamber and supplying a given amount of the cleaning agent to the distillation chamber for cleaning the distillation chamber in a cleaning cycle.

In order to anticipate the features of claim 1, the Examiner has a burden to show that all features are disclosed by a single

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reference. The Examiner cannot meet this burden and has admitted such.

The Examiner further admits that Weber and Breithaupt do not disclose or even suggest at least a required feature of claim 1, specifically:

The apparatus of Weber or Breithaupt differs from the claimed invention in that claim 1, for example, recites "a cleaning agent chamber containing a cleaning agent, said cleaning agent chamber communicating with said distillation chamber and supplying a given amount of said cleaning agent to said distillation chamber for cleaning said distillation chamber in a cleaning cycle."

To make up for this clear deficiency with both Weber and Breithaupt, the Examiner attempts to combine each of these two patents with either of the two inventions created by the inventor of the instant application. To do this, however, the Examiner has a particular burden that must be overcome before such conclusion can be upheld.

When "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the selection made by the applicant". *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added).

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"Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination."
In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital et al.*, 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be '**clear and particular.**'" *Winner Int'l Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants respectfully believe that there is no "clear and particular" teaching or suggestion in either Weber or Breithaupt to incorporate the features of either Mansur I or Mansur II, and there is no teaching or suggestion in either Mansur I or Mansur II to incorporate the features of either Weber or Breithaupt.

In establishing a *prima facie* case of obviousness, it is **incumbent upon the Examiner to provide a reason why** one of

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ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicants' disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988).

The Examiner has not provided any reason why one of ordinary skill in the art would have been led to modify the water distillation apparatus of either Weber or Breithaupt with the solvent cleaning apparatus of Mansur I or Mansur II or to combine either Weber's or Breithaupt's and either or Mansur I's or Mansur II's teachings to arrive at the claimed automatic, self-cleaning, household distillation unit of the present invention. The entire support provided by the Examiner rests in a single sentence at the bottom of page 4 of the Office action:

to provide the apparatus of Weber or Breithaupt with a cleaning chamber communicating with the steam chamber for cleaning the stem chamber would have been obvious to one of ordinary skill in the art as such is conventionally done in the art, *inter alia*,

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in order to wash remaining contaminants in said
steam or distillation chamber.

This sentence is simple to summarize: it would have been
obvious to combine either Weber with Breithaupt with either
Mansur I or II because it is obvious to do so.

No reason, rationale, motivation or any other argument is
presented towards satisfying the Examiner's burden in making
this Section 103 combination rejection. Thus, this rejection
must fail.

The only attempt to meet the burden of proof lies in the
Examiner's cite of a few dozen lines of *claim language* in Mansur
I and Mansur II. While claim language can give insight to a
given patent's workings, it is the specification that will
breath life to that claim language. Here, the cited claim
language does not hint at, let alone suggest, cleaning the
distillation chamber of the particular invention. As described
in detail, Mansur I and II both relate to separating solvents
from a cleaning liquid after a dirtied part has been cleaned
using a solvent cleaning liquid. When any cleaning is mentioned
at all in Mansur I, it relates to the cleaning fluid rinsing out
the pre-distillation holding tank 40. This cleaning fluid is
not used at all to clean the distillation chamber 60 nor is it
even used with regard to the distillation chamber 60. Mansur I

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is very clear regarding how the distillation chamber 60 is
supposed to be cleaned:

Removal of the cap 87 facilitates acces to an interior of the distillation chamber 60, enabling accumulated contaminants in the lower central zone to be periodically removed. A tool, such as a spade on a rod, can be used to reach through the port 89 and scrape the bottom of the distillation chamber 60, pulling the accumulated sediment and other contaminants out through the port [87]. Col. 5, lines 9 to 15 (emphasis added by applicant).

Simply put, the user is supposed to physically scrape out the distillation chamber - the same kind of cleaning operation that is present in the prior art existing before the invention of the instant application. There is no automatic cleaning of the Mansur I distillation chamber by any measure, let alone, an automatic cleaner having either "a post-filter heating element for superheating the water in said filter material to clean said filter material during a rejuvenation cycle" or a "cleaning agent chamber communicating with said distillation chamber and supplying a given amount of said cleaning agent to said distillation chamber for cleaning said distillation chamber in a cleaning cycle" as *required* in claim 1.

With respect to Mansur II, lines 36 to 41 of Col. 4 are cited as the only support for cleaning out a distillation chamber.

Because these lines do not explain, suggest, or even hint at the "post-filter heating element for superheating the water in said

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filter material to clean said filter material during a rejuvenation cycle" or the "cleaning agent chamber communicating with said distillation chamber and supplying a given amount of said cleaning agent to said distillation chamber for cleaning said distillation chamber in a cleaning cycle", Applicant cannot determine how these 5 cited lines can relate to the automatic, self-cleaning features of the distillation chamber as set forth in claim 1 of the instant application.

The Examiner has the burden for satisfying the above requirements. But, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in either Weber or Breithaupt or Mansur I or Mansur II or from knowledge available to those skilled in the art.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood

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may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.* (quoting *W.L. Gore & Assocs. Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art. The dependent claims

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are believed to be patentable as well because they all are ultimately dependent on claim 1.

On page 5 of the above-identified Office action, claims 12 to 14 have been rejected as being obvious over Weber or Breithaupt and further in view of United States Patent No. 5,720,856 to Pirone under 35 U.S.C. § 103.

Insofar as claims 12 to 14 are ultimately dependent upon claim 1, and due to the fact that claim 1 is believed to be allowable, it is respectfully believed that these claims are allowable as well.

In view of the foregoing, reconsideration and allowance of claims 1 to 18 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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The extension fee for response within a period of three (3) month(s) pursuant to Section 1.136(a) in the amount of \$510.00 in accordance with Section 1.17 is enclosed herewith.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Gregory L. Mayback, P.A., No. 503,836.

Respectfully submitted,



For Applicant
GLM:cgm

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